

REMARKS

Claims 1-43 are currently pending in the subject application and are presently under consideration. Claims 1, 10, 12, 32, 33, 40, and 43 have been amended as shown on pages 2-7 of the Reply.

Applicant's representative thanks Examiner Takele and her supervisor for the courtesies extended during the telephonic interview conducted on December 13, 2007. Examiners were contacted to discuss the amendments to overcome objections under 35 U.S.C. §103(a) in view of cited art references Kudoh, *et al.* and Leonardos. In particular, Applicant's representative noted that none of the cited references disclose lists that represent alternatives as to how an action may be performed on an object, or that such lists can be associated with a particular object attribute. With regard to these features, the Examiners requested that additional clarifying language be added to the claims with regard to the association between the lists and the object attributes, but otherwise agreed that the cited reference do not appear to teach these features. Participants also discussed the feature of sorting these lists according to sort criteria that is a function of an action performed on an object, and that this criteria can include how recently or how frequently the action has been performed on the object. The Examiners indicated that the wording of these features as currently amended appears acceptable, and that the cited references do not appear to disclose these features. The Examiners offered the opinion that, should the clarifying amendments prove acceptable, the present rejections under 35 U.S.C. §103(a) may be overcome.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-11 Under 35 U.S.C. §103(a)

Claims 1-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kudoh, *et al.* in view of Leonardos (US 2002/0069212). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Kudoh, *et al.* nor Leonardos, alone or in combination, teach or suggest all features set forth in the subject claims.

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).

The subject claims relate to the creation, management, and display of attribute-specific lists in connection with organizing objects. Objects upon which actions can be performed, such as e-mails or files, can have one or more of their object attributes associated with an attribute-specific list. This list can be automatically updated (*e.g.* sorted or appended) based on actions performed on an object having the same associated attribute. The list can include a number of alternative ways in which an action can be performed on the object. For example, when a user receives an e-mail (the object in this example case) from a particular sender (the attribute), and the user wishes to move the e-mail to a particular folder (the action), the user can invoke a list of destination folders associated with the sender of the e-mail and select a destination folder from the list. Upon selecting a destination folder, the list can be re-sorted according to predetermined sort criteria and based on the user’s selection. The sort criteria can be a function of the performed action and can include, but is not limited to, re-sorting based on the most recently selected alternative (in which case the most recently selected alternative would be moved to the top of the list), or re-sorting based on the most frequently selected alternative. This updated list can then be invoked for subsequent objects that contain the same associated attribute. In particular, amended independent claim 1 recites, *in response to a first object being subjected to an action, the first object having a first controlling attribute, updating a first list of a plurality of controlling attribute-specific lists corresponding to the first controlling attribute of the first object according to a sort criterion that is a function of the performed action, each list of the plurality of controlling attribute-specific lists corresponding to a disparate controlling attribute and having a plurality of entries ordered according to the sort criterion and providing alternatives as to how the action can be performed upon objects having the controlling*

attribute.

Contrary to the Examiner's contentions, Kudoh, *et al.* does not disclose these aspects of the subject claims. Kudoh, *et al.* relates to an e-mail cataloging and retrieval system that displays header and classification information for a list of e-mails. The Examiner indicates a section of the cited reference that discloses a header information display that displays e-mail attribute information in a list, with each line representing a single e-mail and including associated attribute information for each e-mail entry. However, these do not represent *alternatives as to how an action can be performed on an object*. Rather, the items in the list disclosed in Kudoh, *et al.* represent e-mails. Although the subject claims disclose that an e-mail can be an object upon which an action is performed (as disclosed in claim 3), an e-mail does not itself represent an alternative way to perform an action on an object. Moreover, Kudoh, *et al.* does not disclose that the indicated lists are associated with a particular object attribute, nor does the cited reference disclose a plurality of such attribute-specific lists, each corresponding to a disparate object attribute.

To more clearly convey that each of a plurality of attribute-specific lists can be made available for invocation *via* an object containing the associated attribute, amended independent claim 1 further recites, *in response to the plurality of controlling-attribute specific lists being invoked via a second object, the second object having a second controlling attribute, displaying a second list of the plurality of controlling attribute-specific lists corresponding to the second controlling attribute of the second object to provide alternatives as to how the action can be performed relative to the second object*. As noted above, Kudoh, *et al.* fails to disclose a plurality of attribute-specific lists that provide one or more alternatives as to how an action can be performed on an object. The cited reference therefore also fails to teach invocation of a second such list associated with a second attribute.

In view of these numerous disparities, it is evident that the attribute-specific lists disclosed by the subject claims are in no way analogous to the e-mail classification lists taught by Kudoh, *et al.*, and as such are not rendered obvious by the cited reference. Leonardos fails to remedy the aforementioned deficiencies of Kudoh, *et al.* with respect to the attribute-specific lists. Leonardos relates to an information management system

that allows a user to create and manage electronic folders in which electronic files can be stored. However, the cited reference does not teach the use of attribute-specific lists as described above.

Amended independent claim 1 also recites, ***in response to a first object being subjected to an action...updating a first list of a plurality of controlling attribute-specific lists corresponding to the first controlling attribute of the first object according to a sort criterion that is a function of the performed action.*** While conceding that Kudoh, *et al.* does not disclose the aforementioned updating feature, the Examiner contends that Leonardos remedies this deficiency, citing in particular Leonardos' feature of searching and sorting the electronic folders or their contents using specified search criteria. However, this search and sort feature of Leonardos in no way suggests updating a *list of alternative ways to perform an action* on an object based on sort criteria that is a *function of the performed action*, or that such an update is *initiated in response to the action being performed on the object*.

With further regard to the sort criteria disclosed in the subject claims, amended claim 9 recites, *the sort criterion is how recently the listed alternatives have been performed*, while amended claim 10 recites, *the sort criterion is how frequently the listed alternatives have been performed*. Again, the Examiner contends that the folder and file sorting criteria disclosed in Leonardos reads on these features. However, as noted above, Leonardos teaches that the sorting of folders or files is based on search criteria entered by a user, and not how recently or frequently the items in the list have been performed. Indeed, since the lists cited by the Examiner represent files, and not alternative ways to perform an action on an object, the action-based sorting criteria disclosed in claims 9 and 10 are not discussed by Leonardos, and therefore are in no way suggested by the cited reference.

Finally, and more generally, applicant's representative notes that amended independent claim 1 relates to a method for updating and displaying an *attribute-specific list*; that is, a list that is specific to a particular object attribute. Conversely, the lists disclosed by the cited references, and relied upon by the Examiner to reject claims 1-11, are not taught as being associated with a particular object attribute. Therefore, the Examiner's suggestion that the attribute-specific lists disclosed in amended independent

claim 1 are obvious in view of the cited references appears to be based on a hindsight interpretation of the references to incorporate applicant's claimed subject matter, since there is no suggestion whatsoever of such *attribute-specific* lists in either Kudoh, *et al.* or Leonardos.

In view of at least the foregoing, it is respectfully submitted that Kudoh, *et al.* and Leonardos, individually or in combination, do not teach or suggest all features disclosed in amended independent claim 1 (and all claims depending there from), and as such fail to make obvious applicant's claimed subject matter. It is therefore requested that this rejection be withdrawn.

II. Rejection of Claims 12-26 Under 35 U.S.C. §103(a)

Claims 12-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kudoh, *et al.* in view of Leonardos (US 2002/0069212). Amended independent claim 12 recites, *updating the at least one attribute-specific list **based on an action performed on at least one object containing the attribute**, and displaying the updated attribute-specific list upon an action performed on a disparate object containing the same attribute*. The Examiner contends that Kudoh, *et al.* discloses this update feature by teaching an electronic mail editing tool that allows a user to modify a selected e-mail. However, the referenced editing features of Kudoh, *et al.* merely disclose that a user may directly edit the contents of an e-mail in the aforementioned electronic mail editing tool. This does not suggest modifying a *list*, much less modifying an attribute-specific list based on an action performed on an object containing the associated attribute. Nor does Kudoh, *et al.* teach that this updated attribute-specific list can be displayed upon an action performed on a *different object containing the same associated attribute*. Leonardos is likewise silent regarding these features. It is therefore respectfully requested that this rejection be withdrawn with respect to amended independent claim 12 (and claims 13-26, which depend there from).

III. Rejection of Claims 27-42 Under 35 U.S.C. §103(a)

Claims 27-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kudoh, *et al.* in view of Leonardos (US 2002/0069212). Amended independent claim 27

recites, *an updating component to update the plurality of objects based on a function performed on an object subject to the one or more controlling attributes; and a display component to display at least one of the plurality of objects upon an action on a second object containing the same one or more controlling attributes.* As discussed above, neither Kudoh, *et al.* nor Leonardos disclose modifying an attribute-specific list based on an action performed on an object containing the associated attribute. The cited references also fail to disclose performing a similar update on a *plurality of objects*, as recited in amended independent claim 27. Nor do the cited references teach or suggest that an attribute-specific list, or a plurality of objects, can be displayed upon an action performed on a different object containing the same attribute, as noted *supra*. In view of these deficiencies in Kudoh, *et al.* and Leonardos, it is respectfully submitted that this rejection should be withdrawn with respect to claim 27, as well as claims 28-47 which depend there from.

IV. Rejection of Claim 43 Under 35 U.S.C. §103(a)

Claim 43 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kudoh, *et al.* in view of Leonardos (US 2002/0069212). Amended independent claim 43 recites, *means for updating the one or more object-specific lists based on an action performed on one or more objects subject to the at least one controlling attribute; [and] means for ordering the one or more object-specific lists based on the one or more ordering criteria, the ordering criteria is a function of the performed action.* As noted *supra*, Kudoh, *et al.* and Leonardos fail to disclose updating a list based on sort criteria that is a *function of a performed action*, or that such an update is *initiated in response to the action being performed on the object*. Consequently, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP289USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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